

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

ANURADHA NARASIMHASWAMY ET AL.

Serial No.: 09/558,192

Filed: April 26, 2000

For: ON-LINE INVENTION DISCLOSURE APPROVAL SYSTEM

Attorney Docket No.: FMC 2086 PUS

Group Art Unit: 2436

Examiner: Carl G. Colin

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Brief in support of an Appeal from the final rejection of claims 1-33 and 37-41 in the Office Action mailed March 12, 2009 for the above-identified patent application.

I. REAL PARTY IN INTEREST

The real party in interest is Ford Motor Company (Assignee).

II. RELATED APPEALS AND INTERFERENCES

There are no appeals, interferences or judicial proceedings known to the Appellants, the Appellants' legal representative, or the Assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-33 and 37-41 are pending in this application. Claims 34-36 have been cancelled. Claims 1-33 and 37-41 have been rejected and are the subject of this appeal.

IV. STATUS OF AMENDMENTS

None.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 provides a method of forming an online invention disclosure comprising forming an invention disclosure online by entering a plurality of selected information including a first inventor identification information from a user computer, Application, p. 9, l. 26 - p. 10, l. 9; p. 10, l. 19 - p. 10, l. 3; p. 12, l. 26 - p. 13, l. 21, as the plurality of selected information is entered into the user computer, storing the selected information in a central storage location, Application, p. 9, l. 26 - p. 10; Fig. 1, 18, prompting approval of said first inventor, Application, p. 10, ll. 9-19; p. 14, ll. 2-13, and after approval, permanently locking the disclosure to prevent further editing of the disclosure, Application, p. 11, ll. 4-12. The method also comprising requesting, from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure, a next available docket identification number for the permanently locked disclosure, Application, p. 11, ll. 4-12; p. 14, l. 25 - p. 15, l. 4; p. 17, ll. 18-30, receiving the next available docket identification number from the docketing system, Application, p. 11, ll. 4-12; p. 14, l. 25 - p. 15, l. 4; p. 17, ll. 18-30, and assigning the docket identification number to the permanently locked disclosure, Application, p. 11, ll. 4-12; p. 14, l. 25 - p. 15, l. 4; p. 17, ll. 18-30.

Claim 12 provides an invention disclosure system comprising a user computer, Fig. 1, 14, a web server having an identification subsystem, Fig. 1, 12, and a database coupled to the server, Fig. 1, 18. The server providing user screens to a user so the user provides disclosure information to said server, Application, p. 9, l. 26 - p. 10, l. 9; p. 10, l. 19 - p. 10, l.

3; p. 12, l. 26 - p. 13, l. 21, receiving disclosure information from the user, Application, p. 9, l. 26 - p. 10, l. 9; p. 10, l. 19 - p. 10, l. 3; p. 12, l. 26 - p. 13, l. 21, storing information in said database, Fig. 1, 18, and prompting the user to provide a password associated with said disclosure, Application, p. 12, l. 26 - p. 13, l. 21. The server also requesting, from a docketing system configured to maintain status information for said disclosure and track due dates for any patent applications originating from said disclosure, a next available docket identification number, Application, p. 11, ll. 4-12; p. 14, l. 25 - p. 15, l. 4; p. 17, ll. 18-30, receiving said next available docket identification number for the disclosure from the docketing system, Application, p. 11, ll. 4-12; p. 14, l. 25 - p. 15, l. 4; p. 17, ll. 18-30, and assigning the docket identification number to the disclosure and allowing access to said disclosure after storing information in said database upon entering the password associated with the disclosure, Application, p. 11, ll. 4-12; p. 14, l. 25 - p. 15, l. 4; p. 17, l. 18 - p. 18, l. 13.

Claim 16 provides an invention disclosure system comprising a user computer, Fig. 1, 14, a server, Fig. 1, 12, and a database coupled to the server, Fig. 1, 18. The server providing user screens to a user to prompt the user to provide disclosure information to said server, Application, p. 9, l. 26 - p. 10, l. 9; p. 10, l. 19 - p. 10, l. 3; p. 12, l. 26 - p. 13, l. 21, receiving disclosure information from the user including a first inventor identification and a second inventor identification, Application, p. 9, l. 26 - p. 10, l. 9; p. 10, l. 19 - p. 10, l. 3; p. 12, l. 26 - p. 13, l. 21, storing information in said database, Fig. 1, 18, prompting the first inventor and the second inventor to provide an approval, Application, p. 10, ll. 9-19; p. 14, ll. 2-13, and permanently locking the disclosure to prevent further editing after the approval by the first inventor and the second inventor, Application, p. 11, ll. 4-12. The server also requesting, from a docketing system configured to maintain status information for said disclosure and track due dates for any patent applications originating from said disclosure, a next available docket identification number, Application, p. 11, ll. 4-12; p. 14, l. 25 - p. 15, l. 4; p. 17, ll. 18-30, receiving said next available docket identification number for the permanently locked disclosure from the docketing system, Application, p. 11, ll. 4-12; p. 14, l. 25 - p. 15, l. 4; p. 17, ll. 18-30,

and assigning the docket identification number to the permanently locked disclosure, Application, p. 11, ll. 4-12; p. 14, l. 25 - p. 15, l. 4; p. 17, ll. 18-30.

Claim 20 provides a method of forming an online invention disclosure comprising forming an invention disclosure online by entering a plurality of selected information including a first inventor identification information and a second inventor identification from a user computer, Application, p. 9, l. 26 - p. 10, l. 9; p. 10, l. 19 - p. 10, l. 3; p. 12, l. 26 - p. 13, l. 21, as the plurality of selected information is entered into the user computer, storing the information in a central storage location, Fig. 1, 18, prompting approval of said first inventor, Application, p. 10, ll. 9-19; p. 14, ll. 2-13, notifying the second inventor, Application, p. 10, ll. 9-19; p. 14, ll. 2-13, prompting the second inventor to approve the disclosure, Application, p. 10, ll. 9-19; p. 14, ll. 2-13, and permanently locking the disclosure to create a locked disclosure to prevent further editing of the disclosure when the second inventor approves the disclosure, Application, p. 11, ll. 4-12. The method also comprising requesting, from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure, a next available docket identification number for the permanently locked disclosure, Application, p. 11, ll. 4-12; p. 14, l. 25 - p. 15, l. 4; p. 17, ll. 18-30, receiving the next available docket identification number for the permanently locked disclosure from the docketing system, Application, p. 11, ll. 4-12; p. 14, l. 25 - p. 15, l. 4; p. 17, ll. 18-30, and assigning the docket identification number to the permanently locked disclosure, Application, p. 11, ll. 4-12; p. 14, l. 25 - p. 15, l. 4; p. 17, ll. 18-30.

Claim 27 provides a method of forming an online invention disclosure comprising entering a plurality of information including one or more inventor identifications from one or more inventors to form an invention disclosure from a user computer, Application, p. 9, l. 26 - p. 10, l. 9; p. 10, l. 19 - p. 10, l. 3; p. 12, l. 26 - p. 13, l. 21, storing the information in a central storage location, Fig. 1, 18, prompting approval of the one or more inventors, Application, p. 10, ll. 9-19; p. 14, ll. 2-13, and permanently locking the disclosure to create a locked disclosure to

prevent further editing of the disclosure after each of the one or more inventors approve the disclosure, Application, p. 11, ll. 4-12. The method also comprising requesting, from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure, a next available docket identification number for the permanently locked disclosure, Application, p. 11, ll. 4-12; p. 14, l. 25 - p. 15, l. 4; p. 17, ll. 18-30, receiving the next available docket identification number for the permanently locked disclosure from the docketing system, Application, p. 11, ll. 4-12; p. 14, l. 25 - p. 15, l. 4; p. 17, ll. 18-30, and assigning the docket identification number to the permanently locked disclosure, Application, p. 11, ll. 4-12; p. 14, l. 25 - p. 15, l. 4; p. 17, ll. 18-30.

Claim 33 provides a method of forming an online document comprising forming a document online by entering a plurality of selected information including a first user identification information from a user computer, Application, p. 9, l. 26 - p. 10, l. 9; p. 10, l. 19 - p. 10, l. 3; p. 12, l. 26 - p. 13, l. 21, storing the selected information in a central storage location, Fig. 1, 18, prompting approval of said first user, Application, p. 10, ll. 9-19; p. 14, ll. 2-13, generating an approval log comprising a date of approval by all inventors, Application, p. 15, ll. 15-24, and associating the approval log with the document, Application, p. 15, ll. 15-24. The method also comprising requesting, from a docketing system configured to maintain status information for the document and track due dates for any patent applications originating from the document, a next available docket identification number for the document, Application, p. 11, ll. 4-12; p. 14, l. 25 - p. 15, l. 4; p. 17, ll. 18-30, receiving the next available docket identification number for the document from the docketing system, Application, p. 11, ll. 4-12; p. 14, l. 25 - p. 15, l. 4; p. 17, ll. 18-30, and assigning the docket identification number to the document, Application, p. 11, ll. 4-12; p. 14, l. 25 - p. 15, l. 4; p. 17, ll. 18-30.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-33 and 37-41 are rejected under 35 U.S.C. 112, first paragraph. Claims 1-11 and 20-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,315,504 (Lemble), U.S. Pat. No. 5,031,214 (Dziewit), Applicants' Admitted Prior Art (AAPA), and U.S. Pat. No. 6,434,580 (Takano). Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemble, Dziewit, AAPA and Takano. Claims 12-15, 33, 37-39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemble, AAPA and Takano. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lemble, AAPA, Takano and Dziewit.

VII. ARGUMENT

A. Claims 1-33 and 37-41 are Patentable Under 35 U.S.C. 112, First Paragraph

The Examiner asserts that

[t]he claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 12, 16, 20, 27, and 33 recite *"requesting, from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure, a next available docket information number for the permanently locked disclosure"*. However, the original specification as filed does not provide enough support for the claims as amended. After careful review and search, Examiner only found page 11 lines 5-12 with figure 2 disclosing *"the accept disclosure transmission block 56 locks the document so no further changes can be made and obtains a docket ID number from a docketing system 58. The disclosure system makes the request and the docket system provides the next available docket number"*. The request mentioned here is a request for docket ID as explicitly illustrated in fig. 2 "requesting docket ID", not a request of a next available docket information

number for the permanently locked disclosure as claimed. Therefore, the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Office Action, March 12, 2009, p. 3 (emphasis in original).

Appellants' Attorney first notes that claim language need not be recited verbatim in the detailed description in order to find support under 35 U.S.C. 112, first paragraph. Appellants' Attorney also draws the Examiner's attention to page 11, lines 4 through 12, page 14, line 25 through page 15, line 4, and page 17, lines 18 through 30 of the Application.

B. Claims 1-11 and 20-32 are Patentable Under 35 U.S.C. 103(a) over Lemble, Dziewit, AAPA and Takano

With regard to claim 1, the Examiner asserts that

Takano is silent about requesting from a docketing system configured to maintain status information for the disclosure and track due dates for any patent application originating from the disclosure. However, these features are either implicit, inherent, or obvious in the system disclosed by Takano between the client computer and the docketing system of the patent office. Applicant's Admitted Prior Art discloses on page 2: "Corporate patent departments also typically maintain a docketing system. The docketing system keeps track of the disclosures as they are processed by the patent department. The docketing system 25 maintains the status of disclosures for the patent attorneys and patent coordinators and of any patent applications originating therefrom. Various due dates of the docket system are also tracked." shows that the docketing system features as claimed are well-known in the art so is a request for a docket ID number as disclosed in US Patent 6,430,581 to Mahoney et al, column 7, lines 1-20.

Therefore, it would have been obvious . . . to implement the invention of Lemble into an invention disclosure environment, by

combining the electronic filing document approval system of Lemble with the features of filing an invention disclosure by inventors and patent attorneys as taught by Takano for the purpose of conveniently preparing a patent application via a transmission and reception of application data between the inventor and other patent application-filing users as suggested by Takano . . . and requesting a docket number and obtaining and assigning a next available docket number to the document from a docketing system that maintains status and track due dates would provide a convenient way to identify the document as suggest by Takano (see column 7, lines 3-10 and column 7, line 64 through column 8, line 6 and column 16, lines 26-65).

Office Action, March 12, 2009, pp. 6-7.

The Examiner's reasoning as to why it would have been obvious to modify Lemble such that it requests, from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure, a next available docket identification number for the permanently locked disclosure appears to be nothing more than an assertion that such modification would provide a convenient way for Lemble to identify documents. Lemble, however, already provides a way to identify its documents: "As APPFUTU, it contains document identification, function identification, approver type and mandatory indicator. It contains also the previous approver's name, one line personal comments from the previous approver, the date and time of previous action." Lemble, col. 10, ll. 7-38 (emphasis added). The Examiner's proposed combination would appear to unnecessarily add redundancy and complexity to the system of Lemble—without any additional functionality. The Examiner's conclusory assertions cannot form the proper basis of a rejection under 35 U.S.C. 103(a). See, MPEP 2142 ("The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.* . . . noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that 'rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of

obviousness."") One of ordinary skill would not have had such reason to modify Lemble with Takano.

Additionally, Takano's "reference number" (of columns 7 and 8) appears to be assigned while the disclosure is initially being entered. See, e.g., Takano, col. 7, ll. 3-10. Hence, Takano, at most, may suggest to one of ordinary skill that a "reference number" should be assigned as part of the process of initially entering an invention disclosure into an invention disclosure system. Claim 1 requests and assigns a docket number after the disclosure has been approved and locked: any disclosure having a docket number has thus already been approved and locked. Such is not the case with Takano's reference number. All disclosures of Takano (or Lemble as modified by Takano), whether approved/locked or not, will have a reference number. Lemble as modified by Takano does not yield the claimed invention.

Claims 20 and 27 are patentable for the reasons claim 1 is patentable.

Claims 2-11, 21-26 and 28-32 are patentable because they depend from one of claims 1, 20 and 27.

C. Claims 16-19 are Patentable Under 35 U.S.C 013(a) over Lemble, Dziewit, AAPA and Takano

Claim 16 is patentable for the reasons claim 1 is patentable.

Claims 17-19 are patentable because they depend from claim 16.

D. Claims 12-15, 33, 37-39 and 41 are Patentable Under 35 U.S.C. 103(a) over Lemble, AAPA and Takano

Claims 12 and 33 are patentable for the reasons claim 1 is patentable.

Claims 13-15, 37-39 and 41 are patentable because they depend from one of claims 12 and 33.

**E. Claim 40 is Patentable Under 35 U.S.C. 103(a)
over Lemble, Dziewit, AAPA and Takano**

Claim 40 is patentable because it depends from claim 33.

The fee applicable under the provisions of 37 C.F.R. § 41.20(b)(2) is enclosed. Please charge any additional fee or credit any overpayment in connection with this filing to Deposit Account No. 06-1510.

Respectfully submitted,

ANURADHA NARASIMHASWAMY ET AL.

By: /Benjamin C. Stasa/
Benjamin C. Stasa
Registration No. 55,644
Attorney for Appellants

Date: July 24, 2009
BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238
Phone: 248-358-4400; Fax: 248-358-3351

Enclosure - Appendices

VIII. CLAIMS APPENDIX

1. A method of forming an online invention disclosure comprising:
 - forming an invention disclosure online by entering a plurality of selected information including a first inventor identification information from a user computer;
 - as the plurality of selected information is entered into the user computer, storing the selected information in a central storage location;
 - prompting approval of said first inventor;
 - after approval, permanently locking the disclosure to prevent further editing of the disclosure;
 - requesting, from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure, a next available docket identification number for the permanently locked disclosure;
 - receiving the next available docket identification number from the docketing system; and
 - assigning the docket identification number to the permanently locked disclosure.
2. A method as recited in claim 1 further comprising the step of generating an approval log.
3. A method as recited in claim 2 wherein the step of generating an approval log comprises recording the date of an approval.
4. A method as recited in claim 3 further comprising associating the approval log with the disclosure.

5. A method as recited in claim 1 wherein forming is performed by a non-inventor author.

6. A method as recited in claim 1 wherein the step of forming comprises identifying a second inventor; and,

further comprising the steps of notifying the second inventor; and, prompting the second inventor to approve the invention disclosure.

7. A method as recited in claim 6 further comprising revising the disclosure by the second inventor to form a revised disclosure, and prompting the first inventor to approve the revised disclosure.

8. A method as recited in claim 6 wherein prompting the second inventor comprises providing an E-mail to the second inventor.

9. A method as recited in claim 1 wherein prompting comprises the step of prompting the approval of an associated document.

10. A method as recited in claim 9 wherein said associated document is selected from a group consisting of an assignment document and a power of attorney.

11. A method as recited in claim 1 further comprising allowing access to various users for obtaining the information.

12. An invention disclosure system comprising:
a user computer;
a web server having an identification subsystem; and
a database coupled to the server;

said server providing user screens to a user so the user provides disclosure information to said server, receiving disclosure information from the user, storing information in said database, prompting the user to provide a password associated with said disclosure, requesting, from a docketing system configured to maintain status information for said disclosure and track due dates for any patent applications originating from said disclosure, a next available docket identification number, receiving said next available docket identification number for the disclosure from the docketing system, assigning the docket identification number to the disclosure and allowing access to said disclosure after storing information in said database upon entering the password associated with the disclosure.

13. A system as recited in claim 12 further comprising a directory system coupled to said server whereby upon providing identification information to server said server retrieves user information from the directory system in response to the identification information.

14. A system as recited in claim 12 wherein said server creates a user log.

15. A system as recited in claim 14 wherein said server associates said approval log with said disclosure.

16. An invention disclosure system comprising:

a user computer;

a server;

a database coupled to the server;

said server providing user screens to a user to prompt the user to provide disclosure information to said server, receiving disclosure information from the user including a first inventor identification and a second inventor identification, storing information in said database, prompting the first inventor and the second inventor to provide an approval, permanently locking the disclosure to prevent further editing after the approval by the first

inventor and the second inventor, requesting, from a docketing system configured to maintain status information for said disclosure and track due dates for any patent applications originating from said disclosure, a next available docket identification number, receiving said next available docket identification number for the permanently locked disclosure from the docketing system and assigning the docket identification number to the permanently locked disclosure.

17. A system as recited in claim 16 wherein said server generated an approval log associated with said disclosure.

18. A system as recited in claim 17 wherein said server associates said approval log with said disclosure.

19. A system as recited in claim 16 further comprising a directory system coupled to said server whereby upon providing identification information to server, said server retrieves user information from the directory system in response to the identification information.

20. A method of forming an online invention disclosure comprising:
forming an invention disclosure online by entering a plurality of selected information including a first inventor identification information and a second inventor identification from a user computer;
as the plurality of selected information is entered into the user computer, storing the information in a central storage location;
prompting approval of said first inventor;
notifying the second inventor;
prompting the second inventor to approve the disclosure;
permanently locking the disclosure to create a locked disclosure to prevent further editing of the disclosure when the second inventor approves the disclosure;

requesting, from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure, a next available docket identification number for the permanently locked disclosure;

receiving the next available docket identification number for the permanently locked disclosure from the docketing system; and

assigning the docket identification number to the permanently locked disclosure.

21. A method as recited in claim 20 further comprising the step of generating an approval log.

22. A method as recited in claim 21 wherein the step of generating an approval log comprises the step of recording the date of an approval.

23. A method as recited in claim 22 further comprising associating the approval log with the disclosure.

24. A method as recited in claim 6 further comprising locking the disclosure when the second user approves the disclosure.

25. A method as recited in claim 7 further comprising locking the disclosure when the first user approves the revised invention disclosure.

26. A method as recited in claim 8 wherein providing an E-mail to the second inventor comprises providing an E-mail to the second inventor having a hyperlink to the disclosure therein.

27. A method of forming an online invention disclosure comprising:

entering a plurality of information including one or more inventor identifications from one or more inventors to form an invention disclosure from a user computer;
storing the information in a central storage location;
prompting approval of the one or more inventors;
permanently locking the disclosure to create a locked disclosure to prevent further editing of the disclosure after each of the one or more inventors approve the disclosure;
requesting, from a docketing system configured to maintain status information for the disclosure and track due dates for any patent applications originating from the disclosure, a next available docket identification number for the permanently locked disclosure;
receiving the next available docket identification number for the permanently locked disclosure from the docketing system; and
assigning the docket identification number to the permanently locked disclosure.

28. A method as recited in claim 27 further comprising generating an approval log.

29. A method as recited in claim 28 wherein generating an approval log comprises recording the date of an approval from each of the one or more inventors.

30. A method as recited in claim 27 further comprising associating the approval log with the disclosure.

31. A method as recited in claim 27 wherein prompting comprises prompting the one or more inventor comprises providing an E-mail to the one or more inventors.

32. A method as recited in claim 31 wherein providing an E-mail to the one or more inventors comprises providing an E-mail to the one or more inventors having a hyperlink to the disclosure therein.

33. A method of forming an online document comprising:
forming a document online by entering a plurality of selected information including a first user identification information from a user computer;
storing the selected information in a central storage location;
prompting approval of said first user;
generating an approval log comprising a date of approval by all inventors;
associating the approval log with the document;
requesting, from a docketing system configured to maintain status information for the document and track due dates for any patent applications originating from the document, a next available docket identification number for the document;
receiving the next available docket identification number for the document from the docketing system; and
assigning the docket identification number to the document.

37. A method as recited in claim 33 wherein the step of forming comprises identifying a second user; and,
further comprising the steps of notifying the second user; and,
prompting the second user to approve the document.

38. A method as recited in claim 37 further comprising revising the document by the second user to form a revised document, and prompting the first user to approve the revised document.

39. A method as recited in claim 37 wherein prompting the second user comprises providing an E-mail to the second user.

40. A method as recited in claim 37 further comprising permanently locking the document when the second user approves the document.

41. A method as recited in claim 33 wherein said document is selected from a group consisting of an assignment document, an agreement and a power of attorney.

IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.